

REMARKS/ARGUMENTS

This application has been reviewed in light of the Office Action mailed on April 17, 2008. Claims 1-17 are pending in the application with claims 1- 17 amended herein and claims 1 and 8 being recited in independent form. In view of the following amendments and/or remarks, reconsideration and allowance of this application are respectfully requested.

Claim Rejections – 35 U.S.C. §103

The Examiner has rejected claims 1-17 under 35 U.S.C. § 103 (a) as being unpatentable over commonly-owned U.S. Patent No. 5,573,534 to Stone (hereinafter simply referred to as “Stone”) in view of Appleby et al. (U.S. Patent No. 6,391,035) (hereinafter simply referred to as “Appleby”) and Klieman et al. (U.S. Patent No. 5,827,323) (hereinafter simply referred to as “Klieman”). Applicants respectfully submit that Stone, Appleby, or Klieman, or any proper combination thereof, do not render claims 1-17 unpatentable for at least the following reasons.

According to §2143.03 of the MPEP, “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” It is Applicants’ position that all the claim limitations of amended independent claims 1 and 8 of the above-referenced application are not taught or suggested, either expressly or implicitly, by any of the above cited art of record, either taken alone or in any conceivable working combination.

As noted in the present Office Action, the Examiner avers that “Stone discloses the claimed device except for a stop disposed on or adjacent to at least one of the sealing surfaces, the stop being located distally relative to the pivot for maintaining a separation distance...”

Although not disclosed in Stone, the Examiner avers that Appleby teaches the stop configured in a manner as recited in claims 1 and 8.

While Applicants acknowledge that Appleby does disclose the use of a plurality of stops, Applicants respectfully submit that modifying the bipolar instrument disclosed in Stone with the plurality of stops disclosed in Appleby does not render amended claims 1 or 8 unpatentable.

As amended herein, claim 1 recites a laparoscopic bipolar electrosurgical instrument for sealing tissue, including, *inter alia*, "...a plurality of stops for maintaining a minimum separation distance of at least about 0.03 millimeters between opposable sealing surfaces, each of the stops being located distally relative to the pivot and discretely disposed on at least one of jaw members; at least one of the stops being disposed on an opposable seal surface and at least one of the stops being located proximate the pivot..."

Similarly, claim 8 recites a laparoscopic bipolar electrosurgical instrument for sealing tissue, including, *inter alia*, "...a plurality of stops discretely disposed on at least one of the jaw members for maintaining a minimum separation distance between the opposable sealing surfaces, each of the stops being located distally relative to the pivot; at least one of the stops being disposed on an opposable seal surface and at least one of the stops being located proximal the pivot..."

Support for the amendments made to claims 1 and 8 can at least be found in paragraphs [0055], [0056], and in FIGS. 2 and 3 of Applicants' present disclosure.

Nowhere does Appleby teach or suggest a laparoscopic bipolar electrosurgical instrument for sealing tissue, including, *inter alia*, a plurality of stops configured in a manner as required by claims 1 and 8 of Applicants' present disclosure. Appleby relates to "...forceps-type ligating or hemostatic clip removal instrument 10 for removing polymeric ligating or hemostatic clip 12

from the latched condition.” See col. 3, lines 28-32 of the Appleby disclosure. As noted by the Examiner, Appleby teaches, “a stop **84** or **86**, disposed on or disposed adjacent to at least one of the sealing surfaces of two jaw members **80** and **82**, the stop being located distally relative to the pivot **54** about which each of the jaw members is movable.” See col. 4, lines 44-46 and FIG. 2 (reproduced below). According to Appleby, “[t]he outer ends of jaws **80** and **82** are provided with terminal clip engaging surfaces **90** and **92** adjacent the stop surfaces **84** and **86**...” As noted in Appleby, having the jaws **80** and **82** configured in such a manner is critical to the success of removing the clip (see col. 5, lines 33-35).

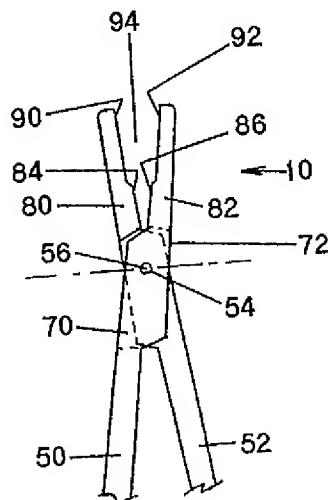


FIG. 2

Nowhere in the Appleby reference is it disclosed that the stop surfaces **84** and **86** may be located at any place on the forceps other than as indicated above. It is Applicants' position that having the stops discretely disposed on at least one of the jaw members, wherein at least one of the stops is disposed on an opposable seal surface and at least one of the stops is located proximate the pivot, as recited in claims 1 and 8, is patentably distinguishable from having the

stops disposed distally and at equal distances from the pivot, as taught by Appleby, since the relative distance between the jaw members may be more accurately controlled along the length of the jaw members which is essential for effective vessel sealing.

Thus, Appleby does not teach or suggest a laparoscopic bipolar electrosurgical instrument for sealing tissue, including, *inter alia*, "...a plurality of stops for maintaining a minimum separation distance of at least about 0.03 millimeters between opposable sealing surfaces, each of the stops being located distally relative to the pivot and discretely disposed on at least one of jaw members; at least one of the stops being disposed on an opposable seal surface and at least one of the stops being located proximate the pivot," as required in claim 1, or a laparoscopic bipolar electrosurgical instrument for sealing tissue, including, *inter alia*, "...a plurality of stops discretely disposed on at least one of the jaw members for maintaining a minimum separation distance between the opposable sealing surfaces, each of the stops being located distally relative to the pivot; at least one of the stops being disposed on an opposable seal surface and at least one of the stops being located proximal the pivot," as required in claim 8.

Accordingly, in view of the foregoing amendments to claims 1 and 8 and in view of the foregoing remarks/arguments, Applicants respectfully submit that the rejection of claims 1 and 8, as being obvious under 35 U.S.C. §103(a) over Stone in view of Appleby has been overcome. Since Stone and/or Appleby, taken alone or in any proper combination, do not teach or suggest each and every element as set forth in claims 1 and 8 the rejections of claims 1 and 8 under 35 U.S.C. § 103(a) should be withdrawn.

Since claims 2-7 and 9-17 depend, directly or indirectly, from claims 1 and 8, respectively, and contain all of the features of claims 1 and 8, Applicants respectfully submit that claims 2-7 and 9-17 are also patentable over Stone in view of Appleby.

The Examiner relies on Klieman for teaching a means for maintaining a closure force between opposable sealing surfaces **40** and **44**. Klieman shows a locking mechanism that allows the end effector pieces **40** and **44** to be “clamped” on tissue or closed during a surgical procedure and kept locked in that closed position. See col. 10, lines 13-15. Applicants respectfully submit that Klieman does not cure the deficiencies of Stone in that Klieman fails to disclose, a plurality of stops...discretely disposed on at least one of opposable seal surface, as required in claims 1 and 8. Accordingly, Applicants submit that claims 1 and 8 and any claims depending either directly or indirect therefrom, namely, claims 2-7 and 9-17 are allowable under 35 U.S.C. 103 (a) over Stone in view of Appleby and in further view of Klieman.

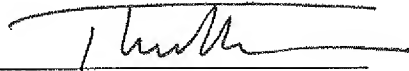
CONCLUSION

In view of the foregoing amendments and/or remarks, it is respectfully submitted that all claims presently pending in the application, namely, claims 1-17, are believed to be in condition for allowance.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicants' undersigned attorney at the Examiner's convenience.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted,



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